

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-20 are pending in this application. By this Amendment, Claims 1, 4, 8, 9 and 15 are amended. Claim 4 is rewritten to be in independent form. Thus, the independent claims are Claims 1, 4 and 13. Claims 1, 8, 9 and 15 are amended to correct informalities. No new matter is added.

The Official Action rejects Claims 1-12 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0089102 A1 to Gedenk, in view of Great Britain Patent No. 931,588 to Simpson. The rejection is respectfully traversed.

Independent Claim 1 recites an axlebox-spring-unit of a railway bogie comprising at least one hydraulic spring having a housing required for a functionality of the hydraulic spring and an axlebox, at least a part of the axlebox forming at least a part of the housing.

Gedenk discloses a hydraulic spring 2 having a spring element 6 attached to an outer ring 8 (see Fig. 1). A cover 12 is secured to the outer ring 8 with a compensating membrane 10 therebetween (see Fig. 1). The Official Action acknowledges that Gedenk fails to disclose the claimed axlebox and housing, but takes the position that these elements are disclosed by Simpson.

Simpson discloses an axlebox 10 as shown in the lone Figure. The axlebox 10 has a cylindrical pillar including three resilient bushes 14 bonded to inner and outer shells 15 and 16. The Official Action appears to take the position that the cylindrical pillar of the axlebox 10 corresponds to the claimed housing. A vertical guide pillar 18 is slidable in the bushes 14. A load applied to the guide pillar 18 is transferred to the inner shell 15 of the top bush 14 and is resisted by the resilient

material, which transfers the load to the outer shell 16 (see page 1, column 2, lines 60-64). The Official Action takes the position that it would have been obvious to one skilled in the art to provide Gedenk's hydraulic spring 2 with Simpson's axlebox 10 and cylindrical pillar "so the spring can serve as the primary suspension for the railway vehicle" (see last line of page 2 of the Official Action).

This conclusory statement is insufficient to support an obviousness rejection, particularly taking into account the Patent Office's Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103(a) in view of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). The Guidelines state that the Examiner should clearly articulate why the claimed invention would have been obvious. For example, the Supreme Court in *KSR* held that the Examiner "must [provide] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*KSR*, 82 USPQ2d 1385, 1396 (2007)). The Supreme Court noted that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art" (*Id.*). To establish obviousness, it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed" (*Id.*). In this case, it is not at all apparent why one skilled in the art would have been led to the stated modification. For example, Gedenk's hydraulic spring 2 already "serve[s] as the primary suspension for the railway vehicle". That is, the stated modification would not have provided a benefit that does not already exist from Gedenk's construction.

Equally unclear is why the stated design modification would have been obvious to an ordinarily skilled artisan. Simpson discloses that the three bushes 14 act in series to provide adequate deflection while a single resilient bush would be

insufficient (see page 1, column 2, lines 69-72). Gedenk discloses a single hydraulic spring 2 as opposed to multiple hydraulic springs 2 stacked one on top of one another. Thus, the configuration of Simpson's axlebox 10 is such that the modified hydraulic spring-axlebox assembly would not provide adequate deflection and render the assembly unsatisfactory for its intended purpose (see MPEP §2143.01(V)).

Accordingly, the Official Action here fails to explain, with articulated reasoning or rational underpinning, why or how it would have been obvious to provide Gedenk's hydraulic spring 2 with Simpson's axlebox 10 and cylindrical pillar ("housing"). Simply because something could have been modified and a person of ordinary skill was capable of making the modification does not mean it would have been obvious to do so. The Office Action fails to consider the references and claims as a whole and relies on impermissible hindsight using knowledge gleaned only from Applicants' disclosure (see MPEP §2145(X)(A)).

Thus, it would not have been obvious to modify Gedenk's hydraulic spring 2 with Simpson's axlebox 10 and cylindrical pillar ("housing") to result in the combination of features recited in independent Claim 1. Therefore, independent Claim 1 is patentable over Gedenk and Simpson for at least these reasons.

Independent Claim 4 recites all of the features of Claim 1, and is therefore patentable over Gedenk and Simpson for at least the reasons discussed above. In addition, Claim 4 recites that a spring element of the hydraulic spring is directly connected to the part of the axlebox forming at least a part of the housing. Even if Gedenk's hydraulic spring 2 was modified to include Simpson's axlebox 10, the spring element 6 disclosed by Gedenk would not be directly connected to the part of the axlebox 10 forming at least a part of the cylindrical pillar ("housing"). This is because the spring element 6 is attached to the outer ring 8 (see Fig. 1). Thus,

independent Claim 4 is patentable over Gedenk and Simpson for these additional reasons.

Claims 2, 3 and 5-12 are patentable over Gedenk and Simpson at least by virtue of their dependence from patentable independent Claims 1 and 4, respectively, as well as for the additional features these claims recite. For example, Claim 3 recites that the part of the axlebox forms at least a part of a boundary of a volume for a hydraulic fluid of the hydraulic spring. Even if Gedenk's hydraulic spring 2 were modified to include Simpson's axlebox 10, Simpson's axlebox 10 would not form at least a part of a boundary of the hydraulic volume 4a, 4b for a hydraulic fluid of the hydraulic spring 2. This is because Gedenk discloses that the hydraulic volume 4a, 4b is closed off by the spring element 6 on one side and delimited by the compensating membrane 10 on the other side (see Abstract). Thus, Claim 3 is patentable over Gedenk and Simpson for these additional reasons.

Withdrawal of the rejection is respectfully requested.

The Official Action rejects Claims 13-20 under 35 U.S.C. §103(a) over Gedenk in view of Simpson. The rejection is respectfully traversed.

Independent Claim 13 recites an axlebox-spring-unit of a railway bogie comprising an axlebox comprising at least one cup-shaped region, and at least one hydraulic spring adapted to be connected to a frame of the bogie. The at least one hydraulic spring is secured to the axlebox to define together with the cup-shaped region a volume for receiving a hydraulic fluid.

The Official Action acknowledges that Gedenk fails to disclose the claimed axlebox, but takes the position that it would have been obvious to provide Gedenk's hydraulic spring 2 with Simpson's axlebox 10 so the spring can serve as the primary suspension for the railway vehicle (see last three lines of page 3 of the Official

Action). However, as set forth above, it would not have been obvious to modify Gedenk's hydraulic spring 2 with Simpson's axlebox 10 to result in the combination of features recited in independent Claim 13. Therefore, independent Claim 13 is patentable over Gedenk and Simpson for at least these reasons.

Claims 14-20 are patentable over Gedenk and Simpson at least by virtue of their dependence from patentable independent Claim 13. Thus, a detailed discussion of the additional distinguishing features recited in these dependent claims is not set forth at this time. Withdrawal of the rejection is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:


Matthew L. Schneider
Registration No. 32814

David R. Kemeny
Registration No. 57241

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620